

REMARKS

Reconsideration of the objections and rejections set forth in the Office Action dated March 18, 2005, is respectfully requested. The Examiner rejected claims 1-28. Applicants have canceled claims 1-28 without prejudice and have added new claim 29. Accordingly, claim 29 remains pending in the application. No new matter has been added by these amendments as can be confirmed by the Examiner.

A. Formalities.

In the Office Action, the Examiner objected to claim 1, noting a typographical error. Applicants appreciate the Examiner's careful examination of the present application and have included an appropriate correction in new claim 29. The Examiner also rejected claims 13 and 26 under 35 U.S.C. § 112 for allegedly lacking sufficient antecedent basis. In light of Applicants' cancellation of claims 13 and 26, Applicants submit that the Examiner's claim rejections under 35 U.S.C. § 112 are moot.

B. The Prior Art Does Not Disclose or Suggest an Information Transmitting Apparatus that Cyclically Transmits Blocks of Data Subdivided from a Designated Information Apparatus in a Predetermined Sequence upon Receiving Another Request to Transit the Designated Information from Another Information Receiving Apparatus prior to Transmitting all Blocks of Data Subdivided from the Designated Information as Recited in New Claim 29.

In the Office Action, the Examiner rejected claims 1-28 under 35 U.S.C. § 103(a) as allegedly being obvious by Applicants' admitted prior art in view of Harrington et al., United States Patent No. 6,289,012. Applicants respectfully submit, however that, by failing to disclose each and every element of new independent claim 29, neither the admitted prior art nor Harrington et al. anticipates or renders obvious new claim 29. Therefore, it is submitted that new claim 29 is in condition for allowance.

In contrast to the apparatus recited in new claim 29, none of the prior art references, either individually or in combination, disclose or suggest an apparatus that includes an "information transmitting apparatus is arranged and constructed to cyclically

transmit the blocks of data subdivided from the designated information apparatus in a predetermined sequence when the information transmitting apparatus receives another request to transit the designated information from another information receiving apparatus prior to transmitting all blocks of data subdivided from the designated information" as recited in new claim 29. As recognized by the Examiner, **the admitted prior art teaches blocks of data that are cyclically transmitted from a server**. The apparatus of claim 29 however cyclically transmits the blocks of data when the information transmitting apparatus receives another request to transit the designated information from another information receiving apparatus, such as a server, prior to transmitting all blocks of data subdivided from the designated information. Thus, **the apparatus recited in claim 29 receives a signal from the server only after the blocks of data have been transmitted from the server**.

At least one recited element of new claim 29 therefore is totally missing from Applicants' admitted prior art in view of Harrington et al. In accordance with M.P.E.P. § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). The disclosure of a claim element in a prior art reference, when relied upon to negate patentability, must also be clear and unambiguous. Further, "[t]he identical invention must be shown in as complete detail as contained in the...claim." *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, and uniquely important in this case is the requirement that the elements relied on in the prior art reference must be arranged as required by the claim. See *In re Bonds*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Accordingly, since the cited prior art fails to disclose each and every element of independent claim 20, claim 29 is not anticipated. Applicant therefore submits that claim 29 is in condition for allowance.

C. No Motivation Exists to Modify the Teachings of Prior Art in a Manner that Precludes the Patentability of New Claim 29 Under 35 U.S.C. § 103(a).

In accordance with M.P.E.P. § 2142, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met." (M.P.E.P. § 2143.) First, some suggestion or motivation in the prior art references or in the knowledge of one of ordinary skill in the relevant art must exist to modify or combine the references. Second, if the references are combined, a reasonable expectation of success must be shown. Then, finally, all of the claim limitations must be taught or suggested by one reference or a combination of references. To establish a *prima facie* case of obviousness based on a single reference that does not teach all the elements of a claim, the Examiner must provide a rationale for modifying the teachings of the reference. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), *citing*, *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

As discussed above, at least one recited element of claim 29 is totally missing from the cited prior art references. Further, the Examiner does not assert that any teaching or motivation exists in the prior art to modify the prior art in a manner that renders new claim 29 obvious. The Examiner therefore has not established a *prima facie* case under 35 U.S.C. § 103 because, as shown above, all of the elements of the pending claim are not found in the cited references. According, it is submitted that the cited prior art does not anticipate or render obvious new independent claim 29. Applicant therefore submits that claim 29 is in condition for allowance.

For at least the reasons set forth above, it is submitted that new claim 29 is in condition for allowance. A Notice of Allowance is earnestly solicited. The Examiner is encouraged to contact the undersigned at (949) 567-6700 if there is any way to expedite the prosecution of the present application.

Respectfully submitted,

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